



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,798	10/11/2001	Toshihiro Morita	450100-03537	9574

20999 7590 04/28/2004

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

MISTRY, O NEAL RAJAN

ART UNIT	PAPER NUMBER
----------	--------------

2173

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,798

Applicant(s)

MORITA ET AL.

Examiner

O'Neal R Mistry

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 11, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been examined.
2. Claims 1-6 are now pending.

Drawings

3. Figure 1 is objected to for the "box" 5-2, because it requires appropriate descriptive labels. Correction is required.

Specification

4. On page 5 line 8, in the "Description Of The Preferred Embodiments" the word "persona" is mis-spelled. Please make appropriate correction.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3-4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 3 is rejected as being vague for the recitation of "a third icon" in line 3. The claim states a third icon for said display control but there is no recitation of a second icon in the claim or its depending claim.
6. Claim 4 is rejected as being vague for the recitation of "a fourth icon" in line 3. The claim states a fourth icon for said display control but there is no recitation of a second or third icon in the claim or its depending claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6 rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik (US patent # 5,751,287) in view of Hahn (US patent # 5,629,980).

Claim 1, 5, &6 are rejected since Stefik disclosed an information processing apparatus for operating contents recorded in a recording medium that included reading control means for controlling reading out, and the rights information corresponding to the content by (col. 3 line 52-57)" a digital work is any written, aural, graphical or video based work including a computer programs", but did not show a controlling display for a first icon that has rights information for permission of importing the content. That is, Stefik did not disclose the use of different icons to represent varying level of permissions.

Hahn showed (col. 7 line 4-9) that data could be locked using an image icon to display the rights of the folder. "When the file drawer image includes an opened lock icon, such as 760, the user selects the 'Lock Cabinet' command 780 to prevent the contents of the file drawer to be accessed, searched, viewed etc.", in an analogous art for the purpose of iconic representation of access rights for content.

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the system of Stefik with the teachings of Hahn because an icon in Hahn symbolize access rights of data in a repository where the digital works is stored in Stefik's patent, because Stefik mentions digital works can be a graphical or video based program.

The modification of system Stefik with Hahn would have been obvious because one of ordinary skill in the art would have been motivated to search in detail of digital work representation in view of Stefik's citation (col. 16 lines 47) "The user interface for a repository will differ depending on the particular embodiment. The user interface may be a graphical user interface having icons representing the digital works and the various transactions that may be performed." This would have led one in ordinary skill in the art to research more about iconic representation, since Hahn mentioned that a graphical icon representing permission of file access.

Claim 2 further limits claim 1, citing: " a second icon is displayed corresponding to said data, in the event that said rights information indicates permission of check-in of said contents." This equates to an icon allowing to update rights information of content that is being exported to another device. Stefik's disclosed: (col. 35 line 58-65) "updates the usage rights information in the digital work to reflect the number of copies loaned out." This is basically stating that after a file is transferred or loaned out the rights information of the file is updated. However, Stefik fails to teach a second icon to illustrate this feature and with Hahn's teaches (col. 6 lines 61-66) an icon that represents digital works. It would be obvious to a person of ordinary skill in the art at the time of the invention was made to modify the digital works of Stefik to include an iconic representation, as taught by Hahn, for the updated rights information of a file.

One of the ordinary skill in the art would have been motivated to utilize this combination to represent rights information, through a graphical image which was mentioned by Stefik, by using an icon, that was mentioned in Hahn for using a icon for representing file rights.

Claim 3 is rejected because it states: " a third icon is displayed corresponding to said data, in the event that said rights information indicates permission of moving of said contents."; which can be interpreted as having an icon to display authorization for importing or exporting files. This feature is taught by Hahn in Figure 12A and 12B as the process for moving a file folder from one file drawer to another file drawer, but this process can be only done if the file drawer has permission to be accessed in Figure 7A and 7B. It states in Hahn's patent (col. 7 line 1-10): "the contents of a file drawer

associated with a file drawer image are accessible if there is either an opened locked icon on the file drawer image"; which is interpreted as the files also can be imported or exported into the file drawer that is illustrated in Figure 7A. The 'move' function is disclosed by Hahn (col. 9 line 43-51) "Figs. 12A and 12B illustrate the process of moving a file folder from one file drawer to another file drawer." Since, the move function can only be executed when the unlock image is displayed which lets the user know the permission of the file.

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to Hahn's unlock icon that represents file rights of moving, that was mentioned with Stefik digital works, that could be represented as a graphical image.

The modification would have been obvious because one of the ordinary skill in the art would be motivated to search for an icon that represent digital rights for moving files from one location to another.

Claim 4 was rejected because it states: " a fourth icon is displayed corresponding to said data, in the event that said rights information indicates forbidding of check-in of contents". Stefik discloses: (col. 21 line 19-25) " as opposed to there being just a single copy-count for the digital work. The copy-count for a right is decremented each time that a right is exercised. When the Copy-Count equals zero, the right can no longer be exercised."

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to having Hahn's icon graphic represent the digital works of Stefik. This would demonstrate a graphical image that would lock documents, and prevent them from be imported each time the rights was equivalent to zero.

The modification would have been obvious because one of ordinary skill in the art would have been motivated to search for iconic representation after Stefik mention digital works can be represented through graphics, images, and icons. Stefik's digital works has the ability to update usage rights each time a document is imported or exported, that connects to Hahn's icon that display the rights information of a document.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hahn et al (U. S. Patent Number 5,751,287) discloses iconic representation for rights information for data files.

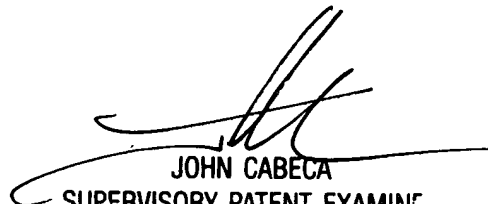
Stefik et al (U.S. Patent Number 5,629,980) discloses for digital works that represents updating rights when copying, and loaning a data file.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to O'Neal R Mistry whose telephone number is (703) 305-2738. The examiner can normally be reached on 9am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W Cabeca can be reached on (703)308-3116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

O'Neal Mistry
Assistant Examiner
Art Unit 2173
April 7, 2003


JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2